

Application No.: 10/664,862
Inventor: MEHLER
Reply to Office Action of 20 December 2006
Docket No.: 53935

REMARKS/ARGUMENTS

Claims 1-9 and 11 are pending. Claims 1 and 11 are amended. Support for amended claim 1 can be found in the specification at least on page 2, lines 9-11 and page 9, lines 4-7. Support for amended claim 11 can be found at least in claim 1 as originally filed and in the specification on page 4, lines 29-35.

No new matter has been added.

Applicant would like to thank Examiner Crepeau for the courtesies extended to its representative while clarifying the correct customer number and associated mailing address for the instant application.

Priority

Applicant has enclosed a certified copy of DE 10243592 as per 35 USC 119(b).

Remarks regarding 35 USC 112

Claim 11 stands rejected for allegedly being indefinite. Applicant's amendment to claim 11 renders the rejection moot. Withdrawal of the rejection is respectfully requested.

Remarks regarding 35 USC 103

Claims 1-5, 8 and 11 stand rejected for allegedly being unpatentable over WO 00/68299. Applicant respectfully disagrees.

To establish *prima facie* obviousness, the Examiner must show in the prior art some suggestion or motivation to make the claimed invention, a reasonable expectation for success in doing so, and a teaching or suggestion of each Claim element (*See, e.g., In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole

(*In re Rouffet*, 149 F.3d 1350, 1355, 1357 (Fed. Cir. 1998)). Rather, to establish a *prima facie* case of obviousness based on a combination of elements disclosed in the prior art, the Examiner must articulate the basis on which it concludes that it would have been obvious to make the claimed invention (*Id.*)

Applicant respectfully asserts that WO 00/68299 relates to polyphenylene ether/polyamide blends. The conductivity of these blends can be adjusted by varying the weight percentage of filler from 0.2 to 3. The fillers are in the form of a mixture of carbon black and carbon fibrils (see e.g., page 3). WO 00/68299 discloses that an application for the aforementioned is as an exterior component for motor vehicles (pages 2 and 11). Further, the polymer phase is described as being present in dispersed form in a continuous phase.

In regard to the exterior motor vehicle components, WO 00/68299 discloses on page 2, lines 11 to 13 that “[i]n the automotive assembly process, it is often desirable to assemble plastic panels and metal body panels onto the automotive frame in the same operation.” Applicant respectfully asserts that the cited art reference clearly is directed towards plastic panels which are intended for assembly onto an automotive frame. In this regard, WO 00/68299 fails to teach, suggest or disclose PEM fuel cells, an assertion the Examiner agrees with by stating the following in the Office Action of 20 December 2006, page 4, “WO ‘299 does not teach or fairly suggest the presence of a PEM fuel cell.”

Moreover, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art (*See, In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). Applicant respectfully asserts the cited art reference fails to teach all the limitations of the instant claimed invention. WO 00/68299 fails to teach, suggest or disclose at least the following: gas-transport channels. Accordingly, because gas-transport channels are not taught by the cited art reference, the 103 rejection is moot and Applicant respectfully requests its withdrawal.

Further, amended claim 11 recites a polymer blend which is filled with conductivity-enhancing carbon fillers. The polymer blend includes at least two mutually nonmiscible blend polymers, wherein the at least two blend polymers form a co-continuous structure and the carbon

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fillers are at a higher concentration in one of the blend polymers or in the phase between the blend polymers.

Applicant respectfully asserts that the polymer blend according to WO 00/68299 does not form a co-continuous structure but has a continuous phase and a dispersed phase (see e.g., the abstract). Thus, the polymer blend according to claim 11 is not taught, suggested or disclosed by the cited art reference because it is fundamentally different from the polymer blend according to WO 00/68299. Because WO 00/68299 provides no disclosure suggesting forming a polymer blend having a co-continuous structure and being filled with carbon fillers which have a higher concentration in one of the blend polymers or in the phase between the blend polymers, claim 11 is also non-obvious in light of WO 00/68299.

The overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art - i.e., the understandings and knowledge of persons having ordinary skill in the art at the time of the invention – fail to support the legal conclusion of obviousness. Consequently, the Examiner has not established a *prima facie* case of obviousness and the rejection under 35 USC §103 should be withdrawn. Favorable action is solicited.

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Conclusion

Applicants respectfully submit that the present application is in condition for allowance, which action is courteously requested. Please charge any shortage in fees due in connection with the filing of this paper to Deposit Account 14.1437. Please credit any excess fees to such account.

Respectfully submitted,
NOVAK DRUCE & QUIGG, LLP

A handwritten signature in black ink, appearing to read 'Todd R. Samelman', is written over a horizontal line.

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